



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,935	08/08/2001	Stuart D. Edwards	9222.16785-CON	5246
26308	7590	09/27/2004	EXAMINER	
RYAN KROMHOLZ & MANION, S.C.			PEFFLEY, MICHAEL F	
POST OFFICE BOX 26618			ART UNIT	PAPER NUMBER
MILWAUKEE, WI 53226			3739	

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Yw

Office Action Summary

Application No.

09/924,935

Applicant(s)

EDWARDS, STUART D.

Examiner

Michael Peffley

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 107-113 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 107-113 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3739

Applicant's arguments, received July 23, 2004, have been fully considered by the examiner. The following is a complete response to the July 23, 2004 communication.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 107-113 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-88 of U.S. Patent No. 6,056,744. Although the conflicting claims are not identical, they are not patentably distinct from each other because the use of mapping electrodes to first detect tissue is deemed an obvious consideration for one of ordinary skill in the art, particularly in view of the Edwards disclosure.

Claims 107-113 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-51 of U.S. Patent No. 6,254,598. Although the conflicting claims are not identical, they are not patentably distinct from each other because the use of mapping electrodes to first detect tissue is

Art Unit: 3739

deemed an obvious consideration for one of ordinary skill in the art, particularly in view of the Edwards disclosure.

Claims 107-113 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,258,087. Although the conflicting claims are not identical, they are not patentably distinct from each other because the use of mapping electrodes to first detect tissue is deemed an obvious consideration for one of ordinary skill in the art, particularly in view of the Edwards disclosure.

Claims 107-113 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,402,744. Although the conflicting claims are not identical, they are not patentably distinct from each other because the use of mapping electrodes to first detect tissue is deemed an obvious consideration for one of ordinary skill in the art, particularly in view of the Edwards disclosure.

Claims 107-113 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 27-52 of U.S. Patent No. 6,077,257. Although the conflicting claims are not identical, they are not patentably distinct from each other because the use of mapping electrodes to first detect tissue is deemed an obvious consideration for one of ordinary skill in the art, particularly in view of the Edwards disclosure.

Claims 107-113 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No.

Art Unit: 3739

6,673,070. Although the conflicting claims are not identical, they are not patentably distinct from each other because the use of mapping electrodes to first detect tissue is deemed an obvious consideration for one of ordinary skill in the art, particularly in view of the Edwards disclosure.

Claims 107-113 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No.

6,613,047. Although the conflicting claims are not identical, they are not patentably distinct from each other because the use of mapping electrodes to first detect tissue is deemed an obvious consideration for one of ordinary skill in the art, particularly in view of the Edwards disclosure.

Claims 107-113 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-90 of U.S. Patent No.

6,749,607. Although the conflicting claims are not identical, they are not patentably distinct from each other because the use of mapping electrodes to first detect tissue is deemed an obvious consideration for one of ordinary skill in the art, particularly in view of the Edwards disclosure.

Claims 107-113 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the pending claims of copending Application No. 09/911,874. Although the conflicting claims are not identical, they are not patentably distinct from each other because the use of mapping electrodes to first detect tissue is deemed an obvious consideration for one of ordinary skill in the art, particularly in view of the Edwards disclosure.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments filed July 23, 2004 have been fully considered but they are not persuasive.

Applicant traverses the double patenting rejections with respect to US Patent Nos. 6,258,087 ('087 patent), 6,402,744 ('044 patent), and 6,077,257 ('257 patent). Applicant has indicated that Terminal Disclaimers for US Patent Nos. 6,056,744, 6,254,598, 6,673,070 and 6,613,047 will be submitted upon indication of allowable subject matter but for the double patenting rejections with these patents. Applicant has not specifically traversed the provisional double patenting rejections of US Application Serial Nos. 09/911,874 and 09/971,085. US Application Serial No. 09/971,085 has since issued as US Patent No. 6,749,607 and the provisional rejection has been withdrawn and replaced with a rejection using the '607 patent.

With regard to the '087, '044 and '257 patents, applicant argues that neither the disclosure nor the claims of these patents include an embodiment using mapping electrodes, nor do the cited patents teach or suggest the use of mapping electrodes. Therefore, the invention claimed in the instant application cannot be an obvious variation of any embodiment disclosed in any of the cited patents. The examiner disagrees.

While none of the '087, '044 or '257 patents specifically disclose the use of the electrodes for mapping tissue, the examiner maintains that several of the cited

Art Unit: 3739

references (i.e. Edwards in US Patent No. 6,056,744) disclose the use of the electrodes to both map and treat (i.e. ablate) tissue. Further, the examiner maintains that it is generally very well known in the art that electrodes may be used to both map and ablate tissue and that no specific teaching of such a well known should be required. However, the examiner stands by the rejections involving the '087, '044 and '257 patents as stated, which rejections state that the use of the electrodes in these patents to also map tissue would be obvious in view of the teaching of Edwards (e.g. 6,056,744).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

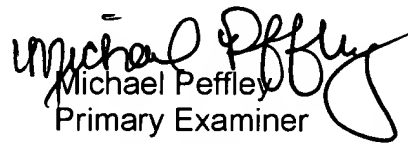
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (703) 308-4305. The examiner can normally be reached on Mon-Fri from 6am-3pm.

Art Unit: 3739

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Michael Peffley
Primary Examiner
Art Unit 3739

mp
September 22, 2004